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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/722,141	11/25/2000	Paul Lapstun	NPS015US	3970

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SILVERBROOK RESEARCH PTY LTD
393 DARLING STREET
BALMAIN, 2041
AUSTRALIA

EXAMINER

TRAN, THAI Q

ART UNIT	PAPER NUMBER
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2616

DATE MAILED: 03/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/722,141

Applicant(s)

LAPSTUN ET AL.

Examiner

Thai Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 November 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1/27/05 & 4/17/01.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Specification

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.
2. The U.S. Application Serial Numbers disclosed in the specification should be updated.

Claim Objections

3. Claim 7 is objected to because of the following informalities: “, a button...” at the end of claim 7 should be changed to --or a button--. Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-7, 9, 11-17, and 19 are rejected under 35 U.S.C. 102(e) as being anticipated by Ellis (US 2004/0226042 A1).

Regarding claim 1, Ellis discloses a video player (Fig. 2) including:

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at least one sensor for sensing coded data on or in a substrate and for generating first data (the selecting of the video-on-demand program disclosed in page 2, paragraph #0030);

a transmitter for transmitting, to a computer system, said first data or second data at least partially based on the first data (receiving the requested program at the distribution facility 26 disclosed in page 3, paragraphs #0038 and #0039);

a receiver for receiving, from the computer system, video data associated with an identity derived from the first data (providing the requested video program to user disclosed in page 3, paragraphs #0038 and #0039); and

at least one display device for outputting a visual display based at least partially on the video data (television 38 disclosed in page 4, paragraphs #0050 and #0051).

Regarding claim 2, Ellis discloses the claimed a memory for storing received video data (video cassette recorder system, digital versatile disc system, laser disc system, optical disc system, magnetic tape and disc system, and magneto-optical system disclosed in page 3, paragraph #0038 or the local memory disclosed in page 6, paragraph #0068 or the videocassette recorder 36 disclosed in page 3, paragraphs #0038 and #0039).

Regarding claim 3, Ellis discloses the claimed wherein at least part of the memory is user replaceable (video cassette recorder system, digital versatile disc system, laser disc system, optical disc system, magnetic tape and disc system, and magneto-optical system disclosed in page 3, paragraph #0038 or the videocassette recorder 36 disclosed in page 3, paragraphs #0038 and #0039).

Regarding claim 4, Ellis discloses the claimed wherein the video player has an identity and further includes processor means to store the identity or data indicative of the identity with or in any file stored in memory (video-on-demand program listings disclosed in page 2, paragraphs #0029 and #0030).

Regarding claim 5, Ellis discloses the claimed a means to display information relating to received video data (info key 53 disclosed in page 4, paragraph #0053).

Regarding claim 6, Ellis discloses the claimed an actuator to enable a user to activate the at least one sensor (the selecting of the video-on-demand program disclosed in page 2, paragraph #0030).

Regarding claim 7, Ellis discloses the claimed wherein the actuator is a force sensor, a button (on-screen select button 12 and YES key 17 disclosed in page 2, paragraph #0030).

Regarding claim 8, Ellis discloses a method of obtaining video data (Fig. 2), the method including:

providing a plurality separately identifiable video data (database 31 disclosed in page 3, paragraph #0038);

associating each of the plurality with one or more identities (video server 29 for supplying video programs to viewers disclosed in page 3, paragraph #0038);

providing at least one substrate having at least one selection data, the at least one selection data associated with or encoding at least one identity (video-on-demand program listings disclosed in page 2, paragraphs #0029 and 0030);

selecting at least one of the at least one selection data of the at least one

substrate with a selection device (the selecting of the video-on-demand program disclosed in page 2, paragraph #0030);

determining the identity or identities associated with the selected selection data and identified the file or files associated with the identity or identities determined from the selection data (receiving the requested program at the distribution facility 26 disclosed in page 3, paragraphs #0038 and #0039); and

downloading the video data identified to the selection device (downloading the video program the home storage device 35 disclosed in page 6, paragraph #0068).

Regarding claim 11, Ellis discloses the claimed wherein the selection data includes machine readable codes (video-on-demand program listings disclosed in page 2, paragraphs #0029 and 0030)

Regarding claim 12, Ellis discloses the claimed playing the video data (downloading the video program the home storage device 35 disclosed in page 6, paragraph #0068).

Regarding claim 13, Ellis discloses the claimed storing the video data in a memory of the selection device (video cassette recorder system, digital versatile disc system, laser disc system, optical disc system, magnetic tape and disc system, and magneto-optical system disclosed in page 3, paragraph #0038 or the videocassette recorder 36 disclosed in page 3, paragraphs #0038 and #0039).

Regarding claim 14, Ellis discloses the claimed wherein the selection device has a unique identity (the selecting of the video-on-demand program disclosed in page 2, paragraph #0030).

Regarding claim 15, Ellis discloses the claimed wherein the selection device has a unique identity and further including storing the video data in memory of the selection device together with association data indicative of an association between the identity of the selection device and the video data (video cassette recorder system, digital versatile disc system, laser disc system, optical disc system, magnetic tape and disc system, and magneto-optical system disclosed in page 3, paragraph #0038 or the local memory disclosed in page 6, paragraph #0068 or the videocassette recorder 36 disclosed in page 3, paragraphs #0038 and #0039).

Regarding claim 16, Ellis discloses the claimed selecting video data stored in memory of the selection device (the selecting of the video-on-demand program disclosed in page 2, paragraph #0030);

extracting from the memory the identity of the selection device associated with the selected video data (selecting the requested video program from the video server 29 disclosed in page 3, paragraph #0038);

comparing the extracted identity with the identity of the selection device (selecting the requested video program from the video server 29 disclosed in page 3, paragraph #0038); and

if the extracted identity and the identity of the selection device are the same, playing the file (downloading the video program the home storage device 35 disclosed in page 6, paragraph #0068).

Regarding claim 17, Ellis discloses the claimed selecting video data stored in memory of the selection device (the selecting of the video-on-demand program disclosed in page 2, paragraph #0030);

extracting from the memory the identity of the selection device associated with the selected video data (selecting the requested video program from the video server 29 disclosed in page 3, paragraph #0038);

comparing the extracted identity with the identity of the selection device (selecting the requested video program from the video server 29 disclosed in page 3, paragraph #0038); and

if the extracted identity and the identity of the selection device are not the same, not playing the file (checking program availability disclosed in page 3, paragraph #0039 and downloading the video program the home storage device 35 disclosed in page 6, paragraph #0068).

Regarding claim 19, Ellis discloses the claimed wherein the substrate has visible data associated with at least one selection data (video-on-demand program listings disclosed in page 2, paragraphs #0029 and #0030 and info key 53 disclosed in page 4, paragraph #0053).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 8, 10, and 18 rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis (US 2004/0226042 A1).

Regarding claim 8, Ellis discloses all the claimed limitations as discussed in claim 1 above except for providing a motion sensor to enable a user to actuate the video device.

The capability of the using the motion sensor to activate the video device is old and well known in the art and; therefore, Official Notice is taken.

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the well know motion sensor into Ellis's system in order to simplify the process of activating video device.

Regarding claim 10, Ellis discloses all the claimed limitations as discussed in claim 9 above except for providing the claimed wherein the at least one substrate is paper-like.

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The capability of entering data into video device using bar code scanner to scanning bar code is old and well known in the art and; therefore, Official Notice is taken again.

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the well known bar code reader into Ellis's system in order to simplify the process of entering data into video device.

Regarding claim 18, the bar code met the claimed wherein the selection data is invisible or substantially invisible to the average unaided human eye.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The cited references relate to portable video player.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thai Tran whose telephone number is (571) 272-7382.

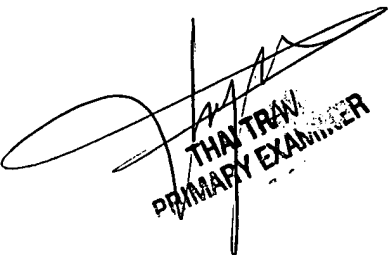
The examiner can normally be reached on Mon. to Friday, 8:00 AM to 5:30 PM.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TTQ



THAI TRAW
PRIMARY EXAMINER